

ESTTA Tracking number: **ESTTA166476**

Filing date: **10/03/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Merck & Co., Inc.
Granted to Date of previous extension	10/03/2007
Address	One Merck Drive, P.O. Box 100 Whitehouse Station, NJ 08889-0100 UNITED STATES
Attorney information	Debra A. Shelinsky Greene Merck & Co., Inc. One Merck Drive, P.O. Box 100 Whitehouse Station, NJ 08889-0100 UNITED STATES debra_greene@merck.com,lisa_hoffmann@merck.com Phone:908-423-5250

Applicant Information

Application No	77035913	Publication date	06/05/2007
Opposition Filing Date	10/03/2007	Opposition Period Ends	10/03/2007
Applicant	Elixir Pharmaceuticals, Inc. 12 Emily Street Cambridge, MA 02139 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. All goods and services in the class are opposed, namely: Pharmaceutical preparations for the treatment of diabetes; Pharmaceutical preparations for the treatment of metabolic syndrome

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	979811	Application Date	08/21/1973
Registration Date	03/05/1974	Foreign Priority Date	NONE
Word Mark	SINEMET		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class U018 (International Class 005). First use: First Use: 1973/07/27 First Use In Commerce: 1973/07/27 MEDICINAL PREPARATION FOR USE IN THE TREATMENT OF CERTAIN AFFECTIONS OF THE NERVOUS SYSTEM

U.S. Application No.	78773912	Application Date	12/15/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	JANUMET		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2007/04/11 First Use In Commerce: 2007/04/11 Pharmaceutical preparations for the treatment of addiction, urinary incontinence, diabetes, cardiovascular diseases and disorders, cerebrovascular diseases and disorders, anxiety, depression, insomnia, cognitive disorders, diseases and disorders of the central nervous system, gastrointestinal diseases and disorders, obesity, inflammation and inflammatory diseases, respiratory diseases and disorders, musculo-skeletal disorders and osteoporosis, Anti-infective preparations; Anti-viral preparations; Immunological preparations; Analgesic preparations; Antiemetic preparations		

U.S. Application No.	78934999	Application Date	07/21/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	JANUMET		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2007/04/11 First Use In Commerce: 2007/04/11 Pharmaceutical preparations for the treatment of diabetes		

Attachments	78773912#TMSN.jpeg (1 page)(bytes) Sinemet v Zenomet.pdf (6 pages)(24525 bytes) 78934999#TMSN.jpeg (1 page)(bytes)
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Signature	/debra shelinsky greene/
Name	Debra A. Shelinsky Greene
Date	10/03/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of application Serial No. 77/035913 published in the Official Gazette
on June 5, 2007.

Merck & Co., Inc.

Opposer,

Opposition No. _____

v.

Elixir Pharmaceuticals, Inc.

Applicant,

NOTICE OF OPPOSITION

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

MERCK & CO., INC., a corporation duly organized and existing under the laws of the State of New Jersey, with its principal place of business located at One Merck Drive, Whitehouse Station, New Jersey 08889-0100, believes it will be damaged by the registration of Application Serial No. 77/035,913 for the designation ZENOMET as a trademark for “pharmaceutical preparations for the treatment of diabetes; pharmaceutical preparations for the treatment of metabolic syndrome” (hereinafter “Applicant’s Goods”) filed November 3, 2006 by Elixir Pharmaceuticals, Inc. and published in The Official Gazette of June 5, 2007, page TM 377, and having previously been granted an extension of time to oppose, hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is a leading research driven pharmaceutical products and services company which discovers, develops, manufactures and markets a broad range of innovative medical and pharmaceutical products and services designed to improve and preserve human health.
2. Since long prior to the filing date of the application herein opposed, Opposer has been a world business leader which distributes and sells medical and pharmaceutical preparations throughout the United States and the world.
3. Since long prior to the filing date of the application herein opposed, the trademark SINEMET has been used and continues to be used in interstate commerce for a “medicinal preparation for use in the treatment of certain affections of the nervous system”. Opposer is the owner on the Principal Register of the registered trademark SINEMET (Reg. No. 979,811) for “medicinal preparation for use in the treatment of certain affections of the nervous system”. Registration issued on March 5, 1974, is in full force and effect, and has become incontestable under the provisions of Section 15 of the Lanham Act (15 U.S.C. Section 1065).
4. Since long prior to the filing date of the application herein opposed, Opposer and its licensee have distributed and offered for sale and sold

pharmaceutical preparations bearing the trademark SINEMET which identifies and distinguishes its pharmaceutical preparations from those of others.

5. Since long prior to the filing date of the Applicant, Opposer and its licensee have made use of the trademark SINEMET by applying it to labeling, packaging, product literature and other materials distributed in interstate commerce.
6. As a result of the quality of Opposer's products and their widespread use in the healthcare industry, the trademark SINEMET has come to have great value to Opposer and the health care industry has come to use the mark to identify and distinguish Opposer's goods from those of others.
7. Opposer is the owner of pending application number 78/934,999 for JANUMET and pending application number 78/773,912 for JANUMET with design. Both of these applications have been allowed and Statements of Use have been submitted for both, setting forth a first use date of April 11, 2007. Both applications set forth pharmaceuticals "for the treatment of diabetes" as their goods. Applicant's goods, identified to be offered for sale and for distribution under the designation ZENOMET, are intended for the same class of purchasers and users as those intended for JANUMET and JANUMET with design.

8. Upon information and belief, Applicant filed its application to register the designation ZENOMET as a trademark on November 3, 2006 and under Section 1(b) of the Trademark Law on the basis of intent to use in interstate commerce.
9. Upon information and belief, Applicant has made no use of the designation ZENOMET on or in connection with Applicants' goods identified in the application .
10. Upon information and belief, Applicants' goods to be offered for sale under the mark ZENOMET are related to the goods sold under Opposer's trademark(s).
11. Applicant's goods, identified to be offered for sale and for distribution under the designation ZENOMET are intended for the same or similar class of purchasers and users as those already familiar with Opposer's registered trademark SINOMET.
12. Applicant's goods, identified to be offered for sale and for distribution under the designation ZENOMET are intended for the same or similar class of purchasers and users as those intended for pending applications for JANUMET and JANUMET with design.

13. Applicant's designation ZENOMET so resembles Opposer's previously registered trademark SINOMET as to be likely, when applied to Applicant's goods, to cause confusion, to cause mistake and to deceive with consequent injury to Opposer and the public.
14. Applicant's designation ZENOMET so resembles Opposer's pending applications for JANUMET and JANUMET with design as to be likely, when applied to Applicant's goods, to cause confusion, to cause mistake and to deceive with consequent injury to Opposer and the public.
15. Opposer will be damaged by the registration sought by Applicant because such registration would support and assist Applicant in the confusing and misleading use of Applicant's mark, would be likely to cause confusion, or to cause mistake or to deceive or to cause confusion as to connection, association or sponsorship of the Opposer and would give color of exclusive statutory rights to Applicant.

WHEREFORE, Opposer respectfully requests that the opposition to the application for registration of the mark ZENOMET be sustained and that the registration sought by Applicant be refused. Please charge the requisite filing fee in the amount of \$300 from Deposit Account No. 13-2752 in the name of Merck & Co., Inc.

Opposer hereby appoints Debra A. Shelinsky Greene, Kevin M. Dugan, Susan C. Mattson and Robert Peverada, each members of the Bar of the State of New York, and

a member of the Bar District of Colombia, or any of them, the addresses of each being c/o Merck & Co., Inc., One Merck Drive, P.O. Box 100, Whitehouse Station, New Jersey 08889-0100, to file the foregoing Notice of Opposition, to prosecute this opposition, with full powers of substitution and revocation, to make all alterations and amendments therein, and to transact all business and acts in the United States Patent and Trademark Office in connection therewith.

Dated: Whitehouse Station, New Jersey
October 3, 2007

Merck & Co., Inc.

BY: /debra shelinsky greene/
Debra A. Shelinsky Greene

For: Opposer